

Appl. No. : 09/762,568  
Filed : July 30, 2001

### REMARKS

The claims have been amended to more clearly claim the present invention. Claims 1, 2, 4-8 and 15 were examined. Of these, Claims 1 and 5-7 have been allowed. Claims 2, 4, 8, and 15 have been amended. Claims 16-18 were previously withdrawn pending allowance of dependent Claim 2 at which point Applicants have respectfully requested rejoinder. The changes made to the Specification and Claims by the current amendment, including ~~deletions~~ and additions, are shown herein with deletions designated with a strikethrough and additions underlined. No new matter has been added herewith. As a result of the amendment, Claims 1, 2, 4-8, and 15 are presented for further examination.

#### Allowable subject matter

Applicants would like to thank the Examiner for the allowance of Claims 1 and 5-7.

#### Rejection under 35 U.S.C. §112, first paragraph - enablement

The Examiner maintained his rejection of Claims 8 and 15 under 35 U.S.C. §112, first paragraph as to enablement.

The Examiner has acknowledged that the specification is enabling for “a transformant transformed with the plasmid according to claim 2, wherein said transformant in an isolated host cell or a transgenic chicken expressing a GFP transgene, and a method of producing a useful substance in a host cell *in vitro* or producing GFP in a transgenic chicken....” Claim 8 has been amended to recite a transformed cell, wherein said cell is an isolated host cell or transgenic chicken cell. Claim 15 has been amended to recite a method for producing a useful substance wherein the host cell is an isolated host cell or transgenic chicken cell. Applicant submits that the claims are amended are fully enabled, as acknowledged by the Examiner.

In view of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112, first paragraph for lack of enablement.

#### Rejection under 35 U.S.C. §112, first paragraph – written description

The Examiner maintained his rejection of Claims 2, 8 and 15 under 35 U.S.C. §112, first paragraph as lacking written description.

With respect to Claim 2, the Examiner believes that the recitation of a “gene of interest” constitutes new matter. Without acquiescing to the propriety of this rejection, Applicants have amended Claim 2 and dependent Claims 8 and 15 to read a “segment of DNA to be integrated

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into the genome of host cells". There is support for this statement in the Specification as filed, for example on page 19, lines 4-6 which describes D4 as "any DNA to be integrated into the genome of host cells."

Applicants therefore respectfully request withdrawal of the rejection under 35 U.S.C.112, first paragraph for lack of written description.

### **Conclusion**

In view of Applicants' amendments to the claims and the foregoing remarks, it is respectfully submitted that all of the claims are in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

July 30, 2004

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